

REMARKS

Claims 1, 2, 4, 5, 7-13, 15, 16, and 30-36 were pending in this application.

Claims 1, 2, 4, 5, 7-13, 15, 16, and 30-36 have been rejected.

Claim 7 has been amended as shown above.

Claims 1, 2, 4, 5, 7-13, 15, 16, and 30-36 remain pending in this application.

Reconsideration and full allowance of Claims 1, 2, 4, 5, 7-13, 15, 16, and 30-36 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1, 2, 4, 8-10, 12, 13, and 15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,226,997 to Vallier ("*Vallier*"). The Applicants respectfully traverse this rejection.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

First, the Office Action does not reject Claim 7 under 35 U.S.C. § 102 as being anticipated by *Vallier*. Because the Office Action does not reject Claim 7 under § 102, the Office Action cannot established that Claims 8-10 (which depend from Claim 7) are anticipated

by *Vallier*.

Second, Claims 1 and 12 were previously amended to recite pre-forming at least one film of compliant material to “approximately conform” a shape of the film to at least one mold cavity surface. *Vallier* lacks any mention of pre-forming an upper liner (element 12) or a lower liner (element 14) to “approximately conform” the liner to the shape of a mold cavity surface. Instead, *Vallier* specifically recites that the liners may be shaped using a “forming mold” that “dimensionally simulates” another mold. (*Col. 4, Lines 23-31*). As a result, *Vallier* fails to anticipate pre-forming at least one film of compliant material to “approximately conform” a shape of the film to at least one mold cavity surface as recited in Claims 1 and 12 (and their dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1, 2, 4, 8-10, 12, 13, and 15.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 5, 7-11, 16, and 30-36 under 35 U.S.C. § 103(a) as being unpatentable over *Vallier* in view of U.S. Statutory Invention Registration No. H1654 to Rounds (“*Rounds*”). The Applicants respectfully traverse this rejection.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (*Fed. Cir. 1992*)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP*

§ 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

Claim 5 depends from Claim 1. Claims 16 and 34-36 depend from Claim 12. As described above in Section I, Claims 1 and 12 are patentable. As a result, Claims 5, 16, and 34-

36 are patentable due to their dependence from allowable base claims.

Regarding Claim 7, the Office Action withdrew a previous indication of allowability, stating that the Applicants had broadened Claim 7 by including the term “approximately” and by deleting the phrase “during a transfer mold process.” (*Office Action, Page 5, Third paragraph*). Because of this, the Office Action asserts that Claim 7 now “read[s] on the applied prior art and is not in condition for allowance.” (*Office Action, Page 5, Third paragraph*).

The Applicants have amended Claim 7 to remove the phrase “at least approximately” and to add the phrase “during the transfer molding process.” Based on these amendments and the previous indication of allowability, Claim 7 (and its dependent claims) should be patentable over the proposed *Vallier-Rounds* combination.

Moreover, Claims 7, 30, and 34 recite pre-forming multiple “portions” of a tape or film to conform or approximately conform a shape of each portion to a mold cavity surface of a transfer mold. *Vallier* simply recites using separate liners. *Vallier* lacks any mention of using a single liner where multiple “portions” of the liner are conformed to the shape of a mold cavity surface. *Rounds* simply recites the use of liner film. (*Col. 2, Lines 12-25*). *Rounds* also recites that a “reel-to-reel supply” may be used. (*Col. 2, Lines 56-57*). However, *Rounds* lacks any mention of pre-forming multiple “portions” of the liner film to conform or approximately conform a shape of each portion to a mold cavity surface. In fact, *Rounds* lacks any mention of “pre-forming” the liner film at all.

For these reasons, the proposed *Vallier-Rounds* combination fails to disclose, teach, or suggest all elements of Claims 7, 30, and 34 (and their dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 5, 7-11, 16, and 30-36.

III. CONCLUSION

As a result of the foregoing, the Applicants assert that all pending claims in this application are in condition for allowance and respectfully request allowance of the claims.

SUMMARY

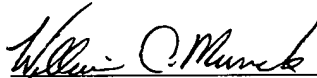
If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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